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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/643,976	08/22/2000	Carl C. Bjornson	7008/92246	1406

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EXAMINER

NAJARIAN, LENA

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/643,976

Applicant(s)

BJORNSON, CARL C.

Examiner

Lena Najarian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 81-88 and 132-145 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 81-88 and 132-145 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20060518</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 5/18/06.

Claims 81-88 and 132-145 remain pending. Claim 144 has been amended.

Drawings

2. The objection to the drawings is hereby withdrawn due to the amendment filed 5/18/06.

Specification

3. The objection to the abstract is hereby withdrawn due to the amendment filed 5/18/06.

Claim Objections

4. The objection to claim 144 is hereby withdrawn due to the amendment filed 5/18/06.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 81-88, 132-136, and 142-144 are rejected under 35 U.S.C. 102(b) as being anticipated by Morgan et al. (5,799,286).

(A) Claims 81-88, 132-136, and 142-143 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

(B) The amendment to claim 144 was apparently made to overcome the claim objection set forth in the prior Office Action. However, these changes do not affect the scope and breadth of the claim as originally presented and/or in the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same rationale given in the prior Office Action, and incorporated herein.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 139-140 and 145 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan et al. (5,799,286) in view of Barnard et al. (5,586,252).

(A) Claims 139-140 and 145 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

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9. Claim 141 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan et al. (5,799,286) in view of Abulleil et al. (US 2001/0027455 A1).

(A) Claim 141 has not been amended and is rejected for the same reasons given in the previous Office Action, and incorporated herein.

10. Claims 137-138 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan et al. (5,799,286) in view of Husseiny (5,210,704).

(A) Claims 137-138 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

Response to Arguments

11. Applicant's arguments filed 5/18/06 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 5/18/06.

(1) Applicant argues that no evidence has been identified to substantiate the interpretation of the word "cost" to be a form of "deficiency."

(2) Applicant argues that there is no showing of how any teaching of Barnard could actually be combined with the financial reports of Morgan, which are not concerned with failure prevention.

(3) Applicant argues that Abulleil discusses **use** of life cycle costs, but discloses nothing about **deriving** such costs in a manner anticipating the subject matter of claim 141.

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(4) Applicant argues that Husseiny provides no disclosure on deriving or using any estimate of the life of a resource.

(A) As per the first argument, the Examiner was unable to find any definition of "deficiency" given with precision, clarity, and deliberateness to warrant the meanings currently argued by Applicant. For example, at pages 16-17 of the response, note the passages relied upon by Applicant for "deficiency."

Applicant's definition of "deficiency" contains exemplary or non-committal phraseology such as "may be" and "can be." As such, the Examiner does not see a strict definition of the term.

In addition, when the Examiner stated that she interpreted "cost" to be a form of "deficiency," she was referring to *wasteful or unnecessary* costs (note col. 2, lines 54-58 of Morgan). Also note claim 82 where Applicant states that "cost" is considered "deficiencies of a resource" (note line 3). As such, the Examiner respectfully submits that the broadest reasonable interpretation of the term "deficiency" would include wasteful or unnecessary costs, which is precisely disclosed by Morgan.

(2) As per the second argument, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

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(3) As per the third argument, the Examiner respectfully submits that claim 141 was rejected by combining Morgan and Abulleil. Abulleil was only relied on for the disclosure relating to life cycle costs. The feature of deriving costs is disclosed by Morgan, for example, at col. 5, lines 48-55.

(4) As per the fourth argument, the Examiner disagrees that Hussein provides no disclosure on deriving or using any estimate of the life of a resource. At col. 2, lines 40-44, Hussein teaches that "there is a need for a measure of life expectancy...to be employed in such...system."

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lena Najarian whose telephone number is


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571-272-7072. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ln
In
7-27-06


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER